

### **REMARKS/ARGUMENTS**

Claims 1-19 and 21-32 are pending. By this Amendment, Claims 1, 13, 15, 17, 18, 27, 29 and 33 are amended. Support for these amendments may be found at least at paragraphs [0053], [0065], [0070] and Figures 6, 8, and 9 of the originally filed Specification.

Applicants respectfully request reconsideration of the present application based on the following remarks.

#### **I. Rejection under 35 U.S.C. § 112, First Paragraph**

Claim 33 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action, on page 2, asserts “The Applicant fails to define ‘processor-readable memory’ in the specification.” The Applicants respectfully traverse the rejection as follows.

The originally filed Specification, in paragraph [0092], recites “[t]he software codes may be stored in a memory unit (e.g., memory 242 in FIG.2) and executed by a processor (e.g., application processor 240). The memory unit may be implemented within the processor or external to the processor.” Therefore, Applicants respectfully submit the Specification does define a “processor-readable memory.”

Accordingly, Applicants respectfully request withdrawal of the rejection.

#### **II. Claims 1-3, 7-13, 15, 18, 21-27, and 29-32 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-3, 7-13, 15, 18, 21-27, and 29-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,284 to Lee, et al. (hereinafter, “Lee”) in view of U.S. Patent Application Publication No. 2001/0016493 to Kim, et al. (hereinafter, “Kim”). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. \_\_\_, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references “must teach or suggest all the claim limitations.” M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at \*\*37. “[R]ejections on obviousness grounds

cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006))*.

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

For example, independent claim 1 recites, among other subject matter, “a first modem processor operative to . . . receive a search message carrying a list of frequencies to search for cells in the second wireless network” and “a second modem processor operative to determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result [and] acquire synchronization and timing for each cell for which pilot acquisition is determined.” (Emphasis added). Independent claims 13, 15, 18, 27, 29 and 33 each include similar subject matter. Lee, alone or in combination with Kim, does not teach or suggest this subject matter.

In making the rejection, the Examiner relies on Lee to show a second modem processor operative to determine pilot acquisition for the list of frequencies. However, the Examiner acknowledges that Lee fails to disclose determining pilot acquisition for additional frequencies not included in the list of frequencies. (See Office Action, page 4).

The Examiner relies on Kim to cure this deficiency. Specifically, the Examiner indicates that Kim teaches “the mobile telephone detects a pilot signal from one of the neighboring base stations and determines whether the detected neighboring base station is included in the list of the neighboring base stations.”

Kim, in the Abstract and paragraphs [0060]–[0062], discloses detecting “a pilot signal from one of the neighboring base stations...[and] if the detected neighboring base station is not included in the list of the neighboring base stations checked...the mobile station recognizes the handoff as failed.” However, Kim does not teach or suggest “determining pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result; [and] acquiring synchronization and timing for each cell for which pilot acquisition is determined,” as recited in claim 13. In contrast, Kim, in paragraph [0062], discloses “if the detected neighboring base station is not included in the list of the neighboring base stations checked...the mobile station recognizes the handoff as failed.”

Therefore, one of skill in the art could not objectively arrive at the subject matter of Applicant's independent claims 1, 13, 15, 18, 27, and 29 regarding "receiving a search message carrying a list of frequencies to search for cells in a second wireless network and determining pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies [and] acquiring synchronization and timing for each cell for which pilot acquisition is determined" without the use of improper hindsight due to the fact that Lee and Kim when combined do not teach or suggest these features.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 13, 15, 18, 27, and 29. Claims 2-3, 7-12, 21-26, and 30-32 depend either directly or indirectly from claims 1 and 18, respectively. Thus, Applicant submits that claims 2-3, 7-12, 21-26, and 30-32 are allowable at least for the reason that they depend from an allowable base claim.

## **II. Claims 4-6, 14, 16, 17, 19, and 28 Rejected Under 35 U.S.C. § 103(a)**

Claims 4-6, 14, 16, 17, 19, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Kim in view of U.S. Patent Application Publication No. 2004/0203469 to Patel, et al. (hereinafter "Patel") and U.S. Patent Application Publication No. 2003/0139184 to Singh, et al. (hereinafter "Singh"). This rejection is respectfully traversed.

Claims 4-6, 14, 16, 19 and 28 depend either directly or indirectly from claims 1, 13, 15, 18, and 27, respectively. Thus, Applicant submits that claims 2-3, 7-12, 21-26, and 30-32 are allowable at least for the reason that they depend from an allowable base claim.

Independent claim 17 includes subject matter similar to that described above in regards to independent claims 1, 13, 15, 18, 27, and 29. For example, among other subject matter, claim 17 recites “means for sending a search message carrying a list of frequencies to search for cells in the second wireless network; means for receiving a search result comprising pilot acquisitions determined for the list of frequencies and additional frequencies not included in the list of frequencies, wherein the search result further comprises each cell with which the wireless device acquired synchronization and timing based on the pilot acquisitions.” As previously discussed, Lee and Kim cannot be combined to render at least this subject matter of claim 17 obvious. Patel and Singh do not cure the deficiencies of Lee and Kim.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 17.

### **III. Claim 17 Rejected Under 35 U.S.C. § 103(a)**

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Singh in view of Patel in view of Kim. This rejection is respectfully traversed.

In making the rejection, the Examiner acknowledges that Singh fails to disclose means for sending a search message carrying a list of frequencies to search for cells in the second wireless network and means for receiving a search result comprising pilot acquisitions determined for the list of frequencies and additional frequencies not included in the list of frequencies. The Examiner relies on Kim to cure this deficiency. (See Office Action, page 10).

As previously discussed, Kim does not teach or suggest “means for receiving a search result comprising pilot acquisitions determined for the list of frequencies and additional frequencies not included in the list of frequencies, wherein the search result further comprises each cell with which the wireless device acquired synchronization and timing based on the pilot acquisitions,” as recited in claim 17. Patel and Singh do not cure the deficiencies of Kim.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claim 17.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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By: /Kristine U. Ekwueme/  
Kristine Ekwueme, Reg. No. 56,344  
(858) 658.1901

QUALCOMM Incorporated  
Attn: Patent Department  
5775 Morehouse Drive  
San Diego, California 92121-1714  
Telephone: (858) 658-1901  
Facsimile: (858) 658-2502